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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,100

07/14/2006

Ali N. Syed

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1720

2387 7590 06/22/2009

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EXAMINER

LEA, CHRISTOPHER RAYMOND

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,100	<b>Applicant(s)</b> SYED ET AL.	
	<b>Examiner</b> Christopher R. Lea	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8-19,21-25,28-31,33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) 4,18,19 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,8-17,24,25,28-31,33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/20/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This application is a 371 (national stage application) of PCT/US05/03462 which claims benefit to US Provisional application 60/540,176.

Receipt of Amendments/Remarks filed on February 20, 2009, is acknowledged. In response to Non-final office action dated October 22, 2009, applicant amended claims 1, 8, 16, & 24, canceled claim 2, and added new claims 35-40. Claims 1, 3, 4, 8-19, 21-25, 28-31, 33, & 35-40 are pending. Claims 1, 3, 8-17, 24, 25, 28-31, 33, & 35-40 are under examination.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. All new rejections applied have been necessitated by applicant's amendment to the claims. They constitute the complete set presently being applied to the instant application.

### ***Information Disclosure Statement***

1. The information disclosure statement(s) (IDS) submitted on February 20, 2009, was filed after the mailing date of the first office action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97 & 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3, 8, 9, & 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al. (US Patent 6,238,653) in view of Lorenz et al. (US Patent 5,989,530) and Cincotta et al. (US PreGrant Publication 2002/0155962).

### **Applicant claims**

Applicant claims a substantially anhydrous, free-flowing composition for hair lightening containing a peroxy salt compound and a water-dispersible, self-emulsifying, fatty acid-derived hair conditioner made up of a combination of materials.

### **Determination of the scope and content of the prior art (MPEP 2141.01)**

Narasimhan et al. teach, as a whole, a composition for the bleaching of hair.

Narasimhan et al. teach a composition for hair-lightening comprising an aqueous phase (which comprises 1-99% of the composition, given that the instant specification defines "substantially anhydrous" as water content less than 10% of the composition as a whole, this limitation may be met by the composition taught by Narasimhan et al.) containing hydrogen peroxide, an oil phase, and an organic amphiphilic surfactant (abstract & column 2, lines 25-37). Narasimhan et al. teach capric/caprylic triglycerides among the possible oils in the oil phase (column 5, line 20). Narasimhan et al. teach PEG sorbitan peroleate (column 6, line 45-67) and glyceryl esters, specifically cocoate, (column 7, lines 15-36) among the surfactants for use in the composition. Narasimhan et al. teach that in the process of bleaching hair, the composition is combined, immediately before use, with an aqueous alkaline solution then applied to hair (column 17, lines 26-46).

Note that for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as

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equivalent to “comprising.” (See MPEP § 211.03) Also note that generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. (See MPEP § 2144.05 II.A)

**Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)**

The difference between the teachings of Narasimhan et al. and the instant claims is that Narasimhan et al. does not teach peroxy salts or all of the claimed species of conditioners. These deficiencies in Narasimhan et al. are cured by the teachings of Lorenz et al. and Cincotta et al.

Lorenz et al. teach, as a whole, a powdery hair bleaching (lightening) composition.

Lorenz et al. teach using peroxide salts such as potassium and ammonium persulfate as bleaching agents (column 2, lines 8-11). Lorenz et al. disclose a solution of hydrogen peroxide (an aqueous medium) which is mixed with the anhydrous free-flowing composition to form an emulsion (column 2, line 27-33).

Cincotta et al. teach, as a whole, a non-aqueous (hence substantially anhydrous) composition to style hair which contains many optional hair conditioners (fixatives, humectants, emollients, etc.)

Cincotta et al. teach a vast number of hair conditioners (as emollients) which may be included in combination in a hair active composition (paragraph 47). Caprylic/capric triglyceride (a fatty ester, a C3-C4 polyol ester of a C6-C22 fatty acid), glyceryl

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citrate/lactate/linoleate/oleate (fatty esters, glyceryl ester of a C6-C22 fatty acid and at least one acid selected from the group consisting of citric, lactic, succinic acids), and PEG-40 sorbitan peroleate (a polyethoxylated C12-18 acylated sorbitol ester) are among the emollients taught (paragraph 47). The glyceryl cocoate/citrate/lactate part of the elected species is met by the glyceryl citrate/lactate/linoleate/oleate and glyceryl cocoate taught (paragraph 47, the "/" in these names is interpreted to mean a combination of the listed monoesters, as such the combination of citrate/lactate/linoleate/oleate and cocoate necessarily includes the combination of cocoate/citrate/lactate).

**Finding of *prima facie* obviousness  
Rationale and Motivation (MPEP 2142-2143)**

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to substitute persulfates for hydrogen peroxide in the composition taught by Narasimhan et al. and produce the instant invention. The skilled artisan would have been motivated to use persulfates because Lorenz et al. teaches them as suitable bleaching agents in anhydrous hair-lightening compositions.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to use the specifically claimed conditioners in the composition of Narasimhan et al. and produce the instant invention. The skilled artisan would have been motivated to incorporate the claimed conditioners because Narasimhan et al. teaches that they are generically suitable for use in the composition

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and Cincotta et al. teaches that the specifically claimed species are suitable as hair conditioners.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in substituting persulfates for hydrogen peroxide and using the specifically claimed conditioners in the composition of Narasimhan et al. and producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

6. Claims 10-17, 24, 25, 28-31, & 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al., Lorenz et al., and Cincotta et al. as applied to claim 1 above, and further in view of Syed et al. (US Patent 5,756,077).

#### **Applicant claims**

Applicant claims a substantially anhydrous, free-flowing composition for hair lightening containing a water-dispersible, self-emulsifying, fatty acid-derived hair conditioner and a peroxy salt compound.

#### **Determination of the scope and content of the prior art (MPEP 2141.01)**

Detailed discussion of the rejection of claim 1 and the teachings of Narasimhan et al., Lorenz et al., and Cincotta et al. appears above.



Narasimhan et al. teach that the aqueous composition added before use may contain pH adjustors (column 15, lines 20-27) and cationic conditioning polymers (column 8, line 55 through column 9, line 44).

**Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)**

The difference between the teachings of Narasimhan et al., Lorenz et al. and Cincotta et al. and the instant claims is that Narasimhan et al., Lorenz et al. and Cincotta et al. do not teach adding the specifically claimed hair protectants. This deficiency in Narasimhan et al., Lorenz et al. and Cincotta et al. is cured by the teachings of Syed et al..

Syed et al. teach, as a whole, a method for protecting chemically treated hair and a kit for using the compositions to protect hair.

Syed et al. teach that compositions for protecting hair include polyols and cationic polymers (column 3, lines 35-39). Syed et al. teach that compositions for protecting hair include starch hydrolysates and polysaccharides (column 3, lines 35-62). Though maltodextrin is not specifically disclosed, Syed et al. teach the Hystar®, a high molecular weight starch hydrolysate of undefined structure, which by its nature likely contains maltodextrin, a lower molecular weight starch hydrolysate of undefined structure, as a synthetic byproduct. Syed et al. teach including cationic polymers in the hair protectant composition, specifically Merquat 100 (column 6, lines 36-51) which is a tradename for the polymer polyquaternium-6. Syed et al. teach including (in either component) a pH adjustor (column 7, lines 9-10). It would have been within the purview

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of the skilled artisan to optimize the pH for any desired purpose, specifically to an alkaline pH, where hair bleaching treatments containing hydrogen peroxide are more effective. Syed et al. teach that compositions for protecting hair include polyols and cationic polymers (column 3, lines 35-39). Syed et al. teach a post-treatment shampoo with a pH of 4-6 (column 11, lines 9-13). Syed et al. teach including cationic polymers (hair protective agents) in the hair conditioning composition (column 3, lines 35-39). Syed et al. teach a post-treatment shampoo with a pH of 4-6 (column 11, lines 9-13). A shampoo is an aqueous acid medium and it usually contains a nonionic polymer, cationic polymer, or both. Syed et al. teach a kit containing a bleaching composition (claim 22) and further containing a removable affixed (separately packaged) component of a shampoo (claim 26).

**Finding of *prima facie* obviousness  
Rationale and Motivation (MPEP 2142-2143)**

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the hair protectant compositions of Syed et al. with the bleaching composition of Narasimhan et al., Lorenz et al. and Cincotta et al. to improve the hair's post-bleaching condition and produce the instant invention. The skilled artisan would have been motivated to add hair protectants because Syed et al. teach that bleaching and coloring hair causes long-term damage to the hair (column 2, lines 23-35); therefore, a protectant would help to reduce the damage. Further, Syed et al. teaches the possible combination of their protectant composition with a bleaching composition (column 18, lines 37-51).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in combining the hair protectant compositions of Syed et al. with the bleaching composition of Narasimhan et al., Lorenz et al. and Cincotta et al. to improve the hair's post-bleaching condition and producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

In light of the forgoing discussion, one of ordinary skill in the art would have concluded that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-3, 8-17, 24, 25, 28-31, & 33 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

Claims 1, 3, 8-17, 24, 25, 28-31, 33, & 35-40 are rejected. Claims 4, 18, 19, & 21-23 are withdrawn. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lea whose telephone number is (571) 270-5870. The examiner can normally be reached on Mon-Thu 7:30-5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRL

/Johann R. Richter/  
Supervisory Patent Examiner, Art Unit 1616